



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/018,769	12/21/2001	Sandrine Decoster	05725.0993	2464
22852	7590	05/19/2009		
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER YU, GINA C	
			ART UNIT 1611	PAPER NUMBER
			MAIL DATE 05/19/2009	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/018,769

**Applicant(s)**

DECOSTER ET AL.

**Examiner**

GINA C. YU

**Art Unit**

1611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 March 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 18, 20-28 and 30-51 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 18, 20-28, 30-51 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

Receipt is acknowledged of response filed on March 18, 2009. No claim has been amended.

The previous Office action dated December 18, 2008 has been made non-final. The claim rejection made under 35 U.S.C. 103 (a) as indicated in the previous Office action is maintained for the reasons of record.

#### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**Claims 18, 20-28, and 30-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mitsumatsu et al. (WO 99/13830) ("Mitsumatsu") in view of Oshima (JP401009916A) and Sebag et al. (WO 98/03155) ("Sebag").**

Mitsumatsu teaches shampoo formulations comprising trizole, an optical brightener, and either stearyl alcohol or behenyl alcohol. See Examples 3-5. Detergent surfactants such as ammonium lauryl sulfate and cocamidopropylbetaine are used within the claimed amount. See instant claims 37-39. Conditioning agents such as silicone emulsion are used. See instant claims 40-44. See p. 45, lines 9 – 14 for the method of use. See instant claims 49-51.

While Mitsumatsu suggests using cetyl alcohol, stearyl, and behenyl alcohol either individually or as a mixture in p. 24, lines 16 – 20, the reference does not provide a specific example which concurrently uses stearyl alcohol and behenyl alcohol in the ratio as required by instant claim 18.

Oshima teaches a shampoo containing anionic and/or ampholytic surfactant and stearyl alcohol and behenyl alcohol as essential components, wherein the amounts of stearyl (C18) alcohol and behenyl (C22) alcohol are 0.5-5 [sic] wt % and 0.75-7.5 wt %, respectively, and the weight ratio of the alcohols is 1:1.15-4.5. See English abstract; instant claim 18. The shampoo is said to have "beautiful appearance and excellent storage stability, is capable of imparting pearl luster to hair and has excellent hair-conditioning effect".

It would have been obvious to one of ordinary skill in the art at the time of the present invention to modify teaching of Mitsumatsu by using stearyl and behenyl alcohols in the weight ratio as motivated by Oshima, because 1) Mitsumatsu suggests using stearyl and behenyl alcohols within the weight amount which overlaps with Oshima; and 2) Oshima teaches the combination of the two fatty alcohols in a specific ratio in a shampoo formulation which is stable and imparts excellent hair conditioning effect. The skilled artisan would have had a reasonable expectation of successfully producing a stable shampoo formulation.

Mitsumatsu and Oshima fails to teach the opacifier/pearlescent recited in claims 18 and 20--25.

Sebag teaches hair washing and conditioning compositions comprising a dialkyl ether of formula (II) in instant claim 22, and preferably distearyl ether. See English equivalent of Sebag, US 6162423, col. 2, lines 26 – 53; col. 1, lines 4- 66. The reference teaches that the use of at least one fatty dialkyl ether used in the instant invention renders a washing foaming compositions having insoluble silicones and

surfactants, pearlescent effect, good homogeneity, and improved stability while maintaining foaming power. See Example 1, which comprises stearyl alcohol, suggesting the compatibility of the Sebag composition with higher fatty alcohols.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the shampoo composition of the combined references, which comprises silicone emulsion, by adding distearyl ether in the composition as motivated by Sebag, because the latter teaches that the compound renders insoluble silicone and detergent-containing foam compositions pearlescent effect, good homogeneity, and improved stability while maintaining foaming effect. The skilled artisan would have had a reasonable expectation of successfully producing silicone-containing shampoo compositions with pearlescent effect, good homogeneity with improved stability and foams.

#### ***Oath/Declaration***

Declaration filed under 37 C.F.R. 1.132, filed on November 2, 2008, has been fully considered but does not place the application in allowable condition.

#### ***Response to Arguments***

Applicant's arguments filed on March 18, 2009 have been fully considered but they are not persuasive.

Applicant asserts the modification of Mitsumatsu in view of Oshima proposed by the examiner would not have been obvious. Applicant argues that the difference between the amounts of the fatty alcohols used in the two references would have deterred a skilled artisan from manipulating the weight amounts of the C18:C22 fatty

alcohols. The argument is unpersuasive because the motivation to do so is found in the teaching in Oshima which indicates that a shampoo comprising the fatty alcohols in such ratio and the amount produces "beautiful appearance and excellent storage stability", "pearl luster to hair" and "excellent hair-conditioning effect". These desirable benefits for hair cosmetics would have been the driving force to motivate the skilled artisan to manipulate the weight amounts of stearyl and behenyl alcohols of Mitsumatsu.

Applicant also asserts there would have been no reasonable expectation of success in making a shampoo by combining the teachings of the references because each of the Mitsumatsu and Oshima compositions requires components of "divergent" nature. The argument is not persuasive. The mere fact that Mitsumatsu and Oshima teach different ingredients itself does not provide any evidence for a skilled artisan to believe the combination of the Mitsumatsu/Oshima teachings would somehow yield an unstable, inoperable composition. Even the scope of the present claims are open to include any other components not recited in the present claims. A cosmetic composition may require various ingredients which are necessary to make the composition functional and stable, such as surfactants of different charges, proteins, vitamins, glycols, etc. The prior arts already teach how to formulate a composition comprising these various ingredients to make a stable product. In the present case, not all of the Oshima's required components need to be incorporated to the Mitsumatsu formulations; since the Mitsumatsu already discloses shampoo formulations comprising fatty alcohols, a skilled artisan would only have to optimize the weight amount of the

fatty alcohols as taught, suggested, and motivated by Oshima. Even if Oshima's other "essential components", i.e., the at least one kind of ampholytic surfactant having C11-21C alkyl chain and a polypeptide having an average MW of 200-5000, were to be incorporated in the Mitsumatsu shampoo, Oshima already teaches the compatibility of these components with conventional anionic and amphoteric surfactants which form the surfactant base for both prior arts. Thus a skilled artisan would have had a reasonable expectation of making a stable composition in making a stable shampoo product by combining the Mitsumatsu/Oshima teachings.

Applicant argues that Sebag does not cure the alleged deficiencies of the present rejection. Applicant asserts Sebag fails to provide any teaching to combine stearyl and behenyl alcohols. The argument is moot because the obviousness rejection made in view of Mitsumatsu/Oshima is maintained for the reasons of record and as discussed above.

Regarding the declaration filed on December 1, 2008, applicant asserts the comparison data in the declaration shows unexpected results of the present invention. The declaration compares compositions having C18:C22 fatty alcohol ratios of 0.19 and 0.085, and shows that the viscosity of the invention is less temperature dependent than the viscosity of the comparative composition. The data does not reasonably represent the scope of the present claims, which claim the C18:C22 fatty alcohol ratios of from 0.15 to 20. Moreover, claims 32-34 require the fatty alcohol ratios be greater than 0.19, thus applicant's data is clearly not commensurate with the scope of these claims.

Applicant also asserts Oshima does not provide an expectation of the temperature dependent stability result of the declaration, pointing out that Comparative Examples 6 and 7 of Oshima showed poor performance and could not accomplish the object of Oshima's invention. Comparative Examples 6 and 7 have stearyl:behenyl alcohol ratios of 1 and 0.075, respectively, and are said to exhibit a relatively poor temperature stability compared to the preferred ratio of 0.222 to 0.667, according to Oshima. It is respectfully noted that the 1:1 ratio of the fatty alcohol is encompassed by applicant's invention, and Example 6 is still said to exhibit a favorable pearlescence, which is the goal applicant seeks to achieve with the present invention. Nonetheless, at issue is whether the applicant's declaration itself shows sufficient evidence of unexpected results to overcome the prima facie case of obviousness of the present invention. In this case, applicant's actual claimed range of the fatty alcohol ratio is well within the Oshima's specific ratio of the C18:C22 fatty alcohols, namely, from 0.222 to 0.667. A shampoo product with these specific fatty alcohols in the presently claimed weight ratio already has been known in the art and its benefits are also made known to skilled artisans. Since the prior arts provide strong motivation to make the present invention with the claimed fatty alcohol ratio, and applicant's declaration does not overcome the obviousness rejections, examiner views it proper to maintain the obviousness rejections.

### ***Conclusion***

No claims are allowed.



**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GINA C. YU whose telephone number is (571)272-8605. The examiner can normally be reached on Monday through Friday, from 9:00AM until 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sharmila Landau can be reached on 571-272-0614. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Gina C. Yu/  
Primary Examiner, Art Unit 1611